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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,715	05/12/2005	Takanori Uchida	UCHida7	6851
1444	7590	08/18/2006	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			KIM, TAEYOON	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/534,715

Applicant(s)

UCHIDA ET AL.

Examiner

Taeyoon Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-9 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenawalt et al. (U.S. Patent 6,056,970; issued on May 2, 2000).

Claims 1-4 are drawn to a bioabsorbable synthetic nonwoven fabric holding thrombin (claim 1); to a limitation to a material for the bioabsorbable synthetic nonwoven fabric is selected from the group consisting of polyglycolic acid, polylactic acid, and a copolymer of glycolic acid and lactic acid (claim 2); the material of claim 2 being polyglycolic acid (claim 3); thrombin of claim 1 being derived from human blood or a recombinant human thrombin produced by a recombinant DNA technique (claim 4).

Claim 5 is drawn to a hemostatic that uses the bioabsorbable synthetic nonwoven fabric of claim 1.

Claim 6-9 are drawn to a process of preparing the bioabsorbable synthetic nonwoven fabric holding thrombin by the steps of immersing a bioabsorbable synthetic nonwoven fabric into a solution containing thrombin and lyophilizing the obtained nonwoven fabric (claim 6); a limitation to a material for the bioabsorbable synthetic

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nonwoven fabric is selected from the group consisting of polyglycolic acid, polylactic acid, and a copolymer of glycolic acid and lactic acid (claim 7); the material of claim 2 being polyglycolic acid (claim 8); thrombin of claim 1 being derived from human blood or a recombinant human thrombin produced by a recombinant DNA technique (claim 9).

Greenawalt et al. teach a composition comprising hemostatic compounds and bioabsorbable polymers. Greenawalt et al. teach that a hemostatic compound is thrombin and the bioabsorbable polymers are polyglycolide (polyglycolic acid), polylactide (polylactic acid) and copolymers thereof (column 2, lines 34-61; claims 1-9).

Greenawalt et al. also teach thrombin is derived from human plasma or synthetic forms produce by recombinant DNA technology (column 3, lines 52-64; claims 4 and 9).

Greenawalt et al. also teach the bioabsorbable fabric containing thrombin is made by mixing thrombin and bioabsorbable polymers in organic solvent and drying (lyophilizing) the combination (column 5, lines 5-11 and 29-46; claims 6-8).

Therefore, the reference anticipates the claimed subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 14-16 and 20 of copending Application No. 10/542,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications contain claims drawn to a bioabsorbable synthetic nonwoven fabric and thrombin, the bioabsorbable synthetic nonwoven fabric is made of a material selected from the group consisting of polyglycolic acid, polylactic acid, and a copolymer of glycolic acid and lactic

acid, thrombin is derived from either human blood or produced by a recombinant technology; a process/method of preparing the bioabsorbable synthetic nonwoven fabric holding thrombin. Therefore, the claims of '577 anticipate the claims of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

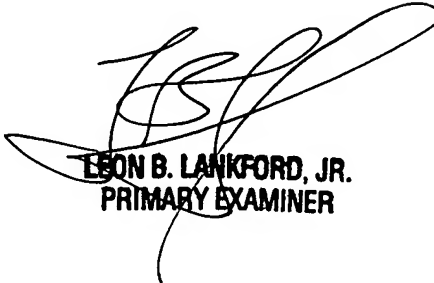
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taeyoon Kim whose telephone number is 571-272-9041. The examiner can normally be reached on 8:00 am - 4:30 pm ET (Mon-Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taeyoon Kim
Patent Examiner
Art Unit 1651



LEON B. LANKFORD, JR.
PRIMARY EXAMINER